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Appl. No. 10/825959
Amdt. dated December 20, 2005
Reply to Restriction Requirement of November 28, 2005

REMARKS

Claims 1-43 are in this case. Claim 43 has been amended for improved clarity and consistency with prior claim 42, and claim 42 has been amended to specify that the claimed article is made by a particular claimed method. None of the amendments made herein constitutes the addition of new matter.

In order to be responsive to the Restriction Requirement, Applicant includes an election herein below, but wishes to emphasize that this election is with traverse for the reasons set out herein.

The Patent Office has required restriction, citing 35 U.S.C. 121. The Examiner has identified three allegedly distinct inventions as follows:

- I. Claims 1-32 and 34 drawn to a method and apparatus for reducing slot width by longitudinally feeding and axially rotating a tubular member, classified in class 72, subclass 95;
- II. Claims 33 and 35-41 drawn to a method and apparatus for reducing slot width in a tubular member, classified in class 72, subclass 214; and
- III. Claims 42 and 43 drawn to a slotted tubular liner, classified in class 428, subclass 34.1.

The Office Action acknowledges that the inventions of Groups II and I are related as combination and subcombination. The Office Action states that the inventions can be shown to be distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. In the instant case, the Office Action states that the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require means for

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feeding and rotating the tube comprising a headstock, chuck, quill, and conveyor, clamping rollers and optical detection. The Office Action states that the subcombination has separate utility such as a conveyor line for processing tubes.

Further, the Office Action states that the claims of Groups I, II and III are related as process of making and product made, and states that the inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process. In the instant case, the Office Action states that the product can be made by another and materially different process such as by using a cutting saw to slot tubes and using a punch tool to sear the slots.

Applicants respectfully traverse the requirement for the reasons set out below. Applicants elect the claims of Group I (claims 1-32 and 34) for examination with traverse. With the election of Group I, Applicants respectfully request reconsideration and withdrawal of the restriction imposed upon Group III, and requests that Group III remain with the elected Group I claims. Applicants reserve the right to pursue any unclaimed subject matter in one or more divisional or continuation applications.

Applicants respectfully request reconsideration, in particular with the Examiner's comment that the product can be made by another and materially different process, such as by using a cutting saw to slot tubes and using a punch tool to sear the slots. Applicants respectfully submit that no prior art showing that other processes can be used to prepare the slotted tubular member having Applicants' specifically recited width tolerance has been provided to support such a statement; hence, there is insufficient reasoning to support a proper restriction in this case. As well, to suggest that a slotted tubular member of claim 42, having slot widths $\leq 3.175\text{mm}$, with variance of no more than $\pm 0.0127\text{ mm}$ along its entire length, could be produced by a cutting saw and

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punch tool, does not appear to Applicants to be a feasible option. Thus, the suggested alternate process warranting the restriction for Group III, in Applicants' respectful submission, appears to be improper. Accordingly, it is urged that retention of the Group III claims with the elected Group I claims is thus required.

Applicants have amended independent claim 42 (Group III) to recite that the slotted tubular member is formed "by the method of claim 26" (Group I). The preamble of dependent claim 43 has been amended to be consistent with the language of claim 42. No new matter has been added with the amendments made herein. Support for the amended claims is found throughout the as-filed specification and original claims. Applicants submit that claims 1-32 and 34 relate to a process and an apparatus specially adapted to carry out the process, while provisionally amended claim 42 and its dependent claim 43 relate to the product produced by the process using the apparatus. A technical relationship between the Group I and Group III claims thus resides in the fact that the process and apparatus of Group I are used to prepare the product of Group III as supported by the as-filed specification. For this reason, Applicants submit that Groups I and III are related, and simultaneous examination of Groups I and III is respectfully requested.

The Office Action states that upon cancellation of claims to a non-elected invention, inventorship must be amended in compliance with 37 C.F.R. 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Applicants state that no change in inventorship is required upon cancellation of claims to any non-elected inventions.

In summary, based upon the above remarks, Applicants respectfully request simultaneous examination of all claims, particularly at a minimum, claims 1-32 and 34 (Group I) with the Group III (claims 42-43).

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Conclusion

In view of the foregoing, it is submitted that this case is in condition for allowance, and passage to issuance is respectfully requested. If there are any outstanding issues related to patentability, the courtesy of a telephone interview is requested, and the Examiner is invited to call to arrange a mutually convenient time.

It is believed that this response does not necessitate the payment of any fees under 37 C.F.R. 1.16-1.17. If this is incorrect, however, please charge any fee due under the foregoing Rules to Deposit Account No. 07-1969.

Respectfully submitted,



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Attorney docket no. 44-03